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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/516,840

05/16/2005

Michitaka Suto

71,039-002

4273

27305

7590

08/02/2007

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1712

MAIL DATE

DELIVERY MODE

08/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,840	<b>Applicant(s)</b> SUTO ET AL.	
	<b>Examiner</b> Marc S. Zimmer	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) 12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/12/07</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

The rejection over Kushibiki et al. is hereby withdrawn in view of Applicant's amendment of claim 1. The Examiner disagrees, however, that any of the other prior art rejections should be withdrawn. Each of these references clearly contemplates in their abstracts the formation of a crosslinked polysiloxane film on a substrate and the subsequent removal of that film from the substrate by a peeling operation. It would appear that Applicant has ignored entirely the teachings of these references.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ona et al., U.S. Patent # 4,557,887 for the reasons made of record in the previous correspondence. See also column 4, lines 12-36.

Claims 1, 5, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Imai et al., U.S. Patent # 6,358,615 for the reasons made of record in the previous correspondence.

Claims 1, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 52-86985 for the reasons made of record in the previous correspondence

Claims 1, 4-6, and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Ito et al., JP 4-20570. Claims 1, 4-6, and 9-11 are rejected for the reasons made of record in the previous correspondence.

Concerning claims 9-11, the Examiner has learned that the reference also mentions aluminum sheets as one of the substrates on which the self-supporting polysiloxane made be form and, thereafter, peeled away. The Examiner sees no patentable distinction between the product obtained upon curing the polysiloxane composition applied to an aluminum sheet and the laminated films of claims 9-11. (Applicant is advised that claim 10 is a product-by-process claim where the process recitation is assessed no patentable weight unless it necessarily yields a product that is distinct in some way from that which is obtained using the approach disclosed by the reference. Given the broad manner in which the laminated film is defined, the Examiner is unable to envisage a difference that sets apart the claimed- and prior art products.)

Claims 1, 3, 4, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mine et al, U.S. Patent # 4,269,753. The Examples teach the formation of polysiloxane sheet 2 mm in thickness- see the claim analysis section in the February 19, 2007 correspondence where the Examiner tried to attach a reasonable definition to

the term film based on the meaning ascribed by *Hawley's Condensed Chemical Dictionary*- derived from a hydrosilylation-curable polysiloxane composition comprising a vinyl group-functional MQ resin.

Claims 1, 2, and 4, are rejected under 35 U.S.C. 102(b) as being anticipated by Katsoulis et al., U.S. Patent # 5,830,950. Katsoulis discloses the formation of molded products/films/sheets (column 8, lines 54-61) from compositions comprising a crosslinkable polysiloxane resin to which is added silicone rubber prepared by crosslinking low degree of polymerization, silanol-terminated polydimethylsiloxane with an orthosilicate. See column 9, lines 47-60. Relevant to the present discussion, one embodiment of the host resin composition to which the aforementioned rubber is added is a mixture of vinyl-endcapped polyphenylsilesequioxane and a compound bearing a plurality of hydrosilyl groups.column 10, line 25 to column 11, line 10.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsoulis et al., U.S. Patent # 5,830,950. Katsoulis does not expressly disclose the production method by which films made from their inventive composition are prepared. It should be noted, however, that they do mention the employment of aluminum molds (column 9, line 4) for making the cured slabs set out in columns 10 and 11. The skilled

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artisan will appreciate that molded products with a small thickness dimension can be made using the same technique but with different molds as was done in *Mine*. Peeling away the crosslinked polymer from the mold completes the process.

***Allowable Subject Matter***

Claims 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner does not consider a crosslinked polysiloxane sheet in a metal mold to be equivalent to the laminated film contemplated by these claims. Claim 14 remains allowable.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 12, 2007

  
MARC S. ZIMMER  
PRIMARY EXAMINER